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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/763,713	10/09/2001	Patrick Pirim	20046H-00080	9181

7590 05/21/2004

Babak S Sani  
Townsend and Townsend and Crew  
Two Embarcadero Center 8th Floor  
San Francisco, CA 94111

EXAMINER
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PHILIPPE, GIMS S

ART UNIT	PAPER NUMBER
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2613

DATE MAILED: 05/21/2004

12

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/763,713

Applicant(s)

PIRIM, PATRICK

Examiner

Gims S Philippe

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 4.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## DETAILED ACTION

This is a first office action in response to application no. 09/763,713 filed on October 9<sup>th</sup> 2001 in which claims 1-28 are presented for examination.

### 1. *Content of Specification*

- (a) Title of the Invention: See 37 CFR 1.72(a) and MPEP § 606. The title of the invention should be placed at the top of the first page of the specification unless the title is provided in an application data sheet. The title of the invention should be brief but technically accurate and descriptive, preferably from two to seven words may not contain more than 500 characters.
- (b) Cross-References to Related Applications: See 37 CFR 1.78 and MPEP § 201.11.
- (c) Statement Regarding Federally Sponsored Research and Development: See MPEP § 310.
- (d) Incorporation-By-Reference Of Material Submitted On a Compact Disc: The specification is required to include an incorporation-by-reference of electronic documents that are to become part of the permanent United States Patent and Trademark Office records in the file of a patent application. See 37 CFR 1.52(e) and MPEP § 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text were permitted as electronic documents on compact discs beginning on September 8, 2000.  
  
Or alternatively, Reference to a "Microfiche Appendix": See MPEP § 608.05(a). "Microfiche Appendices" were accepted by the Office until March 1, 2001.
- (e) Background of the Invention: See MPEP § 608.01(c). The specification should set forth the Background of the Invention in two parts:
  - (1) Field of the Invention: A statement of the field of art to which the invention pertains. This statement may include a paraphrasing of

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the applicable U.S. patent classification definitions of the subject matter of the claimed invention. This item may also be titled "Technical Field."

- (2) Description of the Related Art including information disclosed under 37 CFR 1.97 and 37 CFR 1.98: A description of the related art known to the applicant and including, if applicable, references to specific related art and problems involved in the prior art which are solved by the applicant's invention. This item may also be titled "Background Art."
- (f) Brief Summary of the Invention: See MPEP § 608.01(d). A brief summary or general statement of the invention as set forth in 37 CFR 1.73. The summary is separate and distinct from the abstract and is directed toward the invention rather than the disclosure as a whole. The summary may point out the advantages of the invention or how it solves problems previously existent in the prior art (and preferably indicated in the Background of the Invention). In chemical cases it should point out in general terms the utility of the invention. If possible, the nature and gist of the invention or the inventive concept should be set forth. Objects of the invention should be treated briefly and only to the extent that they contribute to an understanding of the invention.
- (g) Brief Description of the Several Views of the Drawing(s): See MPEP § 608.01(f). A reference to and brief description of the drawing(s) as set forth in 37 CFR 1.74.
- (h) Detailed Description of the Invention: See MPEP § 608.01(g). A description of the preferred embodiment(s) of the invention as required in 37 CFR 1.71. The description should be as short and specific as is necessary to describe the invention adequately and accurately. Where elements or groups of elements, compounds, and processes, which are conventional and generally widely known in the field of the invention described and their exact nature or type is not necessary for an understanding and use of the invention by a person skilled in the art, they should not be described in detail. However, where particularly complicated subject matter is involved or where the elements, compounds, or processes may not be commonly or widely known in the field, the specification should refer to another patent or readily available publication which adequately describes the subject matter.
- (i) Claim or Claims: See 37 CFR 1.75 and MPEP § 608.01(m). The claim or claims must commence on separate sheet or electronic page (37 CFR 1.52(b)(3)). Where a claim sets forth a plurality of elements or steps, each element or step of the claim should be separated by a line indentation.

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There may be plural indentations to further segregate subcombinations or related steps. See 37 CFR 1.75 and MPEP § 608.01(i)-(p).

- (j) Abstract of the Disclosure: See MPEP § 608.01(f). A brief narrative of the disclosure as a whole in a single paragraph of 150 words or less commencing on a separate sheet following the claims. In an international application which has entered the national stage (37 CFR 1.491(b)), the applicant need not submit an abstract commencing on a separate sheet if an abstract was published with the international application under PCT Article 21. The abstract that appears on the cover page of the pamphlet published by the International Bureau (IB) of the World Intellectual Property Organization (WIPO) is the abstract that will be used by the USPTO. See MPEP § 1893.03(e).
- (k) Sequence Listing. See 37 CFR 1.821-1.825 and MPEP §§ 2421-2431. The requirement for a sequence listing applies to all sequences disclosed in a given application, whether the sequences are claimed or not. See MPEP § 2421.02.

2. This application does not contain an **Abstract** of the disclosure as required by 37 CFR 1.72(b). **An abstract on a separate sheet is required.**

**NOTE:**

The Applicant is urged to review the entire application to correct grammatical errors because many words are written in FRENCH (specification and claims) rather than English.

Correction is required.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

In addition, the format followed by the applicant for writing the claims is ambiguous.

Languages such as "characterized in that" must be replaced by "wherein" in order to simplify the claim language.

5. Claims 1-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

**Note: The examiner will show a few examples of the language in the claims in order to help the applicant in making the proper correction.**

Regarding claim 1, the applicant must clearly show the steps performed in the process. Such steps are not well shown. For example, from line 15 to line 19, the claim is vague and indefinite, what is being claimed in the process is rather confusing. In addition, the applicant continues on line 20 to show what steps are included in the process, however,

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the steps are ambiguous. That section of the claim requires a preliminary encoding operation, an additional encoding operation, and a compression operation ... to reduce the number of binary signals by suppression of the majority of the binary signals of said flow whose value is determined within both possible values of such signals. The claim is indefinite because it calls for vague term such as "*the majority of the binary*" and "*both possible values*". The "*majority*" and the "*possible values*" are not defined in the claim, thus, considered vague.

In line 4 of page 112 (or line 34 of the claim), the expression "i.e. comprising" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "i.e."), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d). Also see line 6 of page 113 to correct the same type of problem in the claim.

In line 17 of page 112, the expression "as the compression process is concerned" is not considered as a proper claim language. In addition, the phrases such as "*moreover, at least as regards the luminance component*" is considered as vague.

**Note:** The examiner has pointed out just a few of the problems of claim 1. It is the examiner's belief that a quick review by the applicant's representative will help in clarifying the claim and advancing prosecution. For example, the claim notes <<time constant>>. It is unclear to the examiner whether such language is part of the claim or added for explanation. It appears that the applicant followed a specification format rather than a claim format to claim what he/she believes to be patentable.

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Claim 2 recites the limitation "Mallat diagram" in line 20 of page 114. There is insufficient antecedent basis for this limitation in the claim.

Claim 3, recites the limitation "said signals" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 3, line 12 also recites the expression: *"In order thus to restore the successive frames"*. This expression is not considered to be a proper claim language for two reasons. First, it is the beginning of a new sentence in the middle of the claim, which renders the claim ambiguous because the steps of the process are not in a proper sequence. Second, it is not believe that the process claim needs give the reason for restoring the successive frames.

Claim 4, line 13, recites the expression "if any". This expression renders the claim indefinite since in one case the claim calls for non-displacement (second group of pixels) while the expression "if any" does not call for any displacement representation.

Claims 2-6 are also rejected by dependency to indefinite claim 1.

6. Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.



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For example in lines 6 to 18 of page 118, the expression *"for the compression, it comprises, moreover, at least as regard the luminance in the said input video signal ..."* is vague and indefinite which make examination burdensome.

In addition, the acronyms must be within parenthesis. For example DP in line 23; CO in line 27. the i.e., of line 24 of page 118 renders the claim vague and indefinite because it is considered as a relative term.

7. Claim 7 is also rejected under 35 U.S.C. 112, second paragraph, as being indefinite in that it fails to point out what is included or excluded by the claim language.

This claim is an omnibus type claim.

Claims 8-9 are rejected by dependency. The applicant must review the language of claims 8-9 because they are indefinite also. For example, claim 9, lines 1-2 the expression "A device according to claim 7, characterized in that it comprises means ..." is considered vague and indefinite.

8. Claims 10-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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9. Regarding claim 10, the phrase "circuit and/or software" lines 2 and renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "circuit and/or software"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).

The compression must be either claimed as being performed by a software; or the applicant must claim the circuit performing the compression.

In order to reduce the burden on the examiner, and to avoid future infringement lawsuit, the applicant must clearly state what he/she believes is the invention.

Claims 11-27 are rejected by dependency to claim 10.

**CLAIMS 10-27 WILL BE REJECTED UNDER ART AS BEST UNDERSTOOD BY THE EXAMINER.**

***Claim Rejections - 35 USC § 102***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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11. Claims 10-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Ogata (US Patent no. 5,777,678).

Regarding claim 10, Ogata discloses a video compression apparatus comprising a motion analysis stage, comprising circuitry and/or software designed to identify a pixel of a current frame of a video whose contents correspond to a different pixel of a previous frame of the video, and designed to produce datum coding motion between the pixel of the previous frame and the pixel of the current frame, and at least one other video processing stage of circuitry and /or software interconnected with the motion analysis stage to effect compression of the video (See Ogata fig. 1, motion vector detector 11, motion compensation item 103 and col. 3, lines 11-19, lines 28-67 and col. 4, lines 1-29).

As per claims 11-27, the illustration of fig. 2A, 2B, 4, and 5, provides the limitation of these claims as shown from col. 6 to col. 20.

***Claim Rejections - 35 USC § 112***

12. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

13. Claim 28 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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14. Regarding claim 28, the phrase "circuit and/or software" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "circuit and/or software"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).

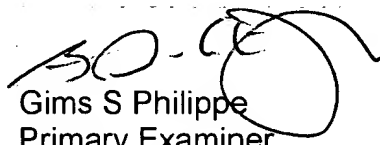
In claim 28, the circuit and or software are considered as two different configurations in a claimed invention. The claim must state whether the steps for the process are performed by the software or by the circuit.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gims S Philippe whose telephone number is (703) 305-1107. The examiner can normally be reached on M-F (9:30-7:00) Second Monday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris S Kelley can be reached on (703) 305-4780. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Gims S Philippe  
Primary Examiner  
Art Unit 2613

GSP

May 18, 2004